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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,092	02/10/2006	Sang-Kee Kim	409-013	7766
47888 7590 01/21/2010 HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER WALKER, NED ANDREW				
ART UNIT		PAPER NUMBER		
3781				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/568,092

**Applicant(s)**

KIM, SANG-KEE

**Examiner**

NED A. WALKER

**Art Unit**

3781

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,4,6-8,10,16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,5,9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 16 and 17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 16 and 17 are directed toward a process of use that has not been previously claimed. The original claims were directed only to the product. The newly submitted claims drawn to the process of use and the original claims drawn to the product are distinct, each from the other because the product as claimed can be used in a materially different process of using that product such as using the product in flattened state to provide a coaster or paperweight. See MPEP § 806.05(h).

Furthermore, there is now an additional examination and search burden for the newly added distinct invention, the burden comprising a separate class and keyword search with respect to combining the cover with a container, which was not previously positively recited as well as the method of enclosing or capping a container and the method of providing a specific relationship and interaction between a cover and a container in the context of their use.

2. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16 and 17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Therefore the resulting claims status is claims 3, 5, 9, and 11-15 are currently pending and claims 1, 2, 4, 6-8, 10, 16, and 17 are currently withdrawn.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**5. Claims 3, 5, 9, and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by McMann (US Pat. No. 1,857,853).**

McMann discloses a container cover (FIGS. 1-2) comprising: a cover plate (19) having a rear surface (lower surface of 19 in FIG. 2); and a closing member (17, 18) having two fixing portions (20, 21) fixed to the cover plate, wherein a first fixing portion (21) is fixed to the cover plate along a peripheral portion of said rear surface of said cover plate (FIG. 2) and a second fixing portion (20) is fixed to the cover plate along a peripheral portion of a second surface of the cover plate (top surface of 19 in FIG. 2), and wherein said closing member includes an annular contact portion (26) integrally formed along a peripheral portion of said two fixing portions (this peripheral portions is considered to be the outer vertically disposed peripheral skirt portion extending from 21 to 22 and integrally formed with top of 26), wherein said annular contact portion is adaptable from a first position wherein it is bent from the two fixing portions toward said second surface (column 2 lines 30-35 disclose body portion 17, 18 is "formed of an elastic material of rubber or suitable rubber composition" and therefore it is capable of assuming this method of use orientation) and extending integrally therefrom to a second position wherein it is bent from the two fixing portions toward said rear surface (column

2 lines 30-35 disclose body portion 17, 18 is "formed of an elastic material of rubber or suitable rubber composition" and therefore it is capable of assuming this method of use orientation); wherein the cover plate has a round formed at a side end of the cover plate along its lower peripheral portion (portion of 19 adjacent 23 in FIGS. 2); wherein no part of said contact portion extends integrally farther than any other part of said contact portion (FIG. 2); wherein the contact portion includes an end having at least one protrusion (22) extending from said end and adapted to press against an outer surface of a container being covered (FIG. 2); wherein said annular contact portion lies essentially parallel to said second surface when said annular contact portion is in the first position (column 2 lines 30-35 disclose body portion 17, 18 is "formed of an elastic material of rubber or suitable rubber composition" and therefore it is capable of assuming this method of use orientation); wherein said container cover can be applied to a container irrespective of the type or size of the container (FIGS. 1-2); wherein said contact portion is integrally connected to both fixing portions (integral to the junction between 20 and 21 as shown in FIG. 2 and therefore either directly or indirectly integrally connected).

### ***Response to Arguments***

6. Applicant's arguments, see amendment filed January 11<sup>th</sup>, 2010, with respect to the rejection of Claims 3, 5, 9, and 11 under 35 USC §102(b) as being anticipated by McMann (US Pat. No. 1,857,853), have been fully considered, but are not persuasive.

Firstly, the Examiner will thoroughly explain his interpretation of the claim language in light of the latest amendment to the claims. The Applicant may be

surprised to learn that the amendment has actually broadened the Examiner's interpretation of the Applicant's claimed subject matter. This is because the amended language added to the last three lines of Applicant's independent claim 3 effectively removed a positive structural limitation and instead replaced it with functional use language, thereby weakening the claim. In fact, the Applicant admits in his own arguments (see page 7, second paragraph, lines 1-3) that the amended language constitutes function use wherein the Applicant states "the annular contact portion is bent towards the top surface of the disc *when the container is in its first position, when the container cover is in use*" (emphasis added). Applicant should appreciate the relative breadth of this type of claim language, which also constitutes the newly added claim 12. The Examiner emphasizes that these new limitations are not drawn to new structure, but are instead drawn to the manner in which applicant intends the invention to be used. Specifically, the amendment incorporates situational language stating that the annular contact portion is adaptable from a first position to a second position. In this context, the Examiner interprets this as a method of use since the claim is now describing a situation where the part in question need only be capable of performing this functional use of adapting from a first use arrangement to a second use arrangement. Furthermore, it has been held that a recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (*In re Hutchison*, 69 USPQ 138). For these reasons, the Examiner has now interpreted the last 3-4 lines as functional use language so McMann need only be capable of performing as such. McMann teaches the feature in question being formed of an elastic material such as rubber or suitable

rubber composition (column 2 line 32-33). The Applicant discloses that a material such as silicone (page 2 lines 27-29) is suitable for the same feature. Considering it is well known that both materials exhibit similar flexibilities, it is reasonable to interpret McMann as capable of performing the Applicant's functional limitations.

It should be appreciated that the applicant's functional language in the claims does not serve to impart patentability. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. The courts have held an apparatus's claims covers what a device is, not what a device does. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior apparatus teaches all the structural limitation of the claims. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-.2 (Fed. Cir. 1997); *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990); *Ex parte Masham*, 2 USPQ 2d 1647 (Bd. Pat. App. & Inter. 1987). While the examiner appreciates Applicant's opinion regarding the new limitations, the Examiner is not convinced that the manner in which substantially all the limitations of the claim(s) are intended to be employed differentiates the claimed apparatus from the prior art.

In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the surface of the cover plate that is away from the container contents, i.e. the second surface"; "when the container cover is in its first position, when the container cover is in use, the annular contact portion must be bent inside out and turned upside

down around an upper rim portion of the container in order to be placed into the second position"; "the present invention does not require or recite the presence of flanges located on the contact portion") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that McMann includes additional structure not required by Applicant's invention, it must be noted that McMann discloses the invention as claimed. The claims in the instant application are written using the transitional phrases "comprising" and "consisting essentially of". The fact that it discloses additional structure not claimed by the Applicant is irrelevant since it does not materially affect the basic and novel characteristics of the claimed invention. See MPEP § 2111.03.

Applicant's argument concerning McMann requiring the use of a flange when the Applicant does not require or recite the presence of a flange is befuddling since the instant Application discloses and illustrates a flange structure in the same position as McMann, denoted by Applicant's 25 in FIG. 8.

Finally, Applicant's argument that the newly added claim 13 differentiates the application from McMann is unconvincing. The Examiner points out that this claim has been treated as having virtually no patentable weight because of the phrase "can be applied". Unlike the terms "must" or "is", "can be" is an optional phrase and therefore any limitation that follows it is given little if any consideration since "can be" indicates that it does not have to always be true. Furthermore the cover is described as being



"applied" to a container. This is extremely broad since we are given no indication of what the context of the application is. For example, if the cover is capable of contacting a container in any way, it is thereby applied to the container.

7. For these reasons, the rejection of Claims 3, 5, 9, and 11 under 35 USC §102(b) as being anticipated by McMann (US Pat. No. 1,857,853), is hereby affirmed, and this rejection is now expanded to include newly added claims 12-15.

### ***Conclusion***

8. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NED A. WALKER whose telephone number is (571)270-3545. The examiner can normally be reached on Monday - Friday 7:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony Stashick/  
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